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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/571,075	09/13/2007	Manuel Angel Albarran Moyo	200312215-3	2399
22879 7590 12/18/2009 HEWLETT-PACKARD COMPANY Intellectual Property Administration 3404 E. Harmony Road Mail Stop 35 FORT COLLINS, CO 80528			EXAMINER PHAM, KHANH B	
			ART UNIT 2166	PAPER NUMBER
			NOTIFICATION DATE 12/18/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/571,075	Applicant(s) ALBARRAN MOYO ET AL.	
	Examiner Khanh B. Pham	Art Unit 2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/27/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 19-22 objected to because of the following informalities:
2. Claims 19-22 recites "**anyone**" at line 2, which should be replace with "any one".

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 19-22 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claims 19-22 recite "**or the like**" at line 3, which render the claims indefinite because the claims include element not actually disclosed, thereby rendering the scope of the claims unascertainable. See MPEP § 2173.05(d).

Appropriate correction is required.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-32, 35, 37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims fail to place the invention squarely within one statutory class of invention. On page 8, line 20 of the instant specification, applicant has provided evidence that applicant intends the “medium” to include signals. As such, the claim is drawn to a form of energy. Energy is not one of the four categories of invention and therefore this claim(s) is/are not statutory. Energy is not a series of steps or acts and thus is not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not a combination of substances and therefore not a composition of matter.

The claims therefore lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category.

Further, Claim 15 is directed to a document stored on a medium, the claims appear to be Nonfunctional descriptive material. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of

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the algorithm was in connection with the programming of a general purpose computer.”).

Claim 32 lacks the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 15-38** are rejected under 35 U.S.C. 102(e) as being anticipated by Lapstun et al. (US 7,623,713 B2), hereinafter “**Lapstun**”.

As per claim 15, Lapstun teaches a computer program product for generating an electronic document comprising:

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- “a computer usable medium having computer usable program code embodied therewith, the computer usable program code comprising: computer usable program code configured to defined the electronic document” at Col. 7 lines 20-30;
- “in which the computer usable program code comprises first and second portions of data” at Col. 7 lines 20-53;
- “in which the first portion of data defines the content of the electronic document” at Col. 7 lines 20-25;
- “and the second portion comprises data relating to a pattern of position identification marking such that when the electronic document is printed, a pattern reading device is able to determined its position relative to position identification marking” at Col. 9 line 60 to Col. 10 line 13;
- “in which the computer usable program code comprises a single data file with the first and second data portions being embedded within the data file” at Col. 14 lines 11-67.

As per claim 16, Lapstun teaches the computer program product of claim 15 which is written such that the computer usable program code can be converted from one format to other formats without losing any of the information from the electronic document” at Col. 31 lines 25-50.

As per claim 17, Lapstun teaches the computer program product of claim 15, in which “the second portion of data comprises metadata and in which the computer

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useable program code includes one or more controls which control the way in which the second portion of data is converted between formats to preserve the pattern" at Col. 11 lines 20-65 and Col. 31 lines 25-50.

As per claim 18, Lapstun teaches the computer program product of claim 16, in which the second portion of data comprises metadata and in which the computer usable program code includes one or more controls which control the way in which the second portion of data is converted between formats to preserved the pattern" at Col. 11 lines 20-65 and Col. 31 lines 25-50.

As per claim 19, Lapstun teaches the computer program product of claim 15, in which the data in the second portion comprises anyone or more of the following: data from which an algorithm or the like can generate the pattern; co-ordinates or other metadata identifying the portion of the position identification marking" at Col. 12 lines 10-65.

As per claim 20, Lapstun teaches the computer product of claim 16, in which "the data in the second portion comprises anyone or more of the following: data from which an algorithm or the like can generate the pattern; co-ordinates or other metadata identifying the portion of the position identification marking" at Col. 12 lines 10-65.

As per claim 21, Lapstun teaches the computer program product of claim 17, in which "the data in the second portion comprises anyone or more of the following: data

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from which an algorithm or the like can generate the pattern; co-ordinates or other metadata identifying the portion of the position identification marking" at Col. 12 lines 10-65.

As per claim 22, Lapstun teaches the computer program product of claim 18, in which "the data in the second portion comprises anyone or more of the following: data from which an algorithm or the like can generate the pattern; co-ordinates or other metadata identifying the portion of the position identification marking"at Col. 12 lines 10-65.

As per claim 23, Lapstun teaches the computer program product of claim 15, in which "the at least one portion providing the position of the position identification markings within the electronic document and/or data identifying the content of the position identification marking in the electronic document is provided in XML" at Col. 30 lines 5-40.

As per claim 24, Lapstun teaches the program product of claim 16 in which "the at least one portion providing the position of the position identification markings within the electronic document and/or data identifying the content of the position identification marking in the electronic document is provided in XML" at Col. 30 lines 5-40.

As per claim 25, Lapstun teaches the program product of claim 17 in which "the at least one portion providing the position of the position identification markings within

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the electronic document and/or data identifying the content of the position identification marking in the electronic document is provided in XML" at Col. 30 lines 5-40.

As per claim 26, Lapstun teaches the program product of claim 18 in which "the at least one portion providing the position of the position identification markings within the electronic document and/or data identifying the content of the position identification marking in the electronic document is provided in XML" at Col. 30 lines 5-40.

As per claim 27, Lapstun teaches the program product of claim 19 in which "the at least one portion providing the position of the position identification markings within the electronic document and/or data identifying the content of the position identification marking in the electronic document is provided in XML" at Col. 30 lines 5-40.

As per claim 28, Lapstun teaches the program product of claim 20 in which "the at least one portion providing the position of the position identification markings within the electronic document and/or data identifying the content of the position identification marking in the electronic document is provided in XML" at Col. 30 lines 5-40.

As per claim 29, Lapstun teaches the program product of claim 21 in which "the at least one portion providing the position of the position identification markings within the electronic document and/or data identifying the content of the position identification marking in the electronic document is provided in XML" at Col. 30 lines 5-40.

As per claim 30, Lapstun teaches the program product of claim 22 in which “the at least one portion providing the position of the position identification markings within the electronic document and/or data identifying the content of the position identification marking in the electronic document is provided in XML” at Col. 30 lines 5-40.

As per claim 31, Lapstun teaches the program product of claim 15 in which “a schema is provided” at Col. 30 lines 5-40.

As per claim 32, Lapstun teaches a system for producing electronic documents comprising:

- “mean for receiving the content of the electronic document” at Col. 9 lines 45-55 and Figs. 1, 25-26;
- “means for receiving data defining a pattern of positional markings allocated to at least a portion of the document” at Col. 9 line 66 to Col. 10 line 13;
- “means for generating data structure defining the electronic document which data structure comprises first and second portion of data, the first portion of data defining the content and the second portion of data relating to the pattern” at Col. 14 lines 10-67 and Figs. 1, 25-26.

As per claim 33, Lapstun teaches a method for generating an electronic document comprising:

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- “creating an electronic file and storing in that file data and metadata, the data defining at least some content” at Col. 9 lines 45-55 and Figs. 1, 25-26;
- “and the metadata relating to a pattern of position identification markings arranged to allow a pattern reading device to determined its position within the position identification markings” at Col. 9 line 66 to Col. 10 line 13,
- “the electronic file capable of generating an electronic document” at Col. 14 lines 10-67 and Figs. 1, 25-26.

As per claim 34, Lapstun teaches the method of claim 33, in which “a file embedding mechanism is used to embed metadata within the electronic document” at Col. 11 lines 20-65.

As per claim 35, Lapstun teaches the computer program product of claim 15, in which “the pattern reading device is a digital pen” at Col. 12 lines 12-22.

As per claim 36, Lapstun teaches the method of claim 33, in which “the pattern reading device is a digital pen” at Col. 12 lines 12-22.

As per claim 37, Lapstun teaches the computer program product of claim 31, in which “the schema is an XML schema” at Col. 30 lines 5-12.

As per claim 38, Lapstun teaches the method of claim 34, in which “the metadata is XML metadata” at Col. 30 lines 5-12.

Response to Arguments

9. Applicant's arguments with respect to claims 15-37 have been considered but are moot in view of the new ground(s) of rejection.

In view of applicant's amendments, the double patenting rejection over pending application 10/571,076 has been withdrawn.

In view of applicant's amendments, the 35 USC 112 1st paragraph rejection has been withdrawn.

Regarding the 101 rejection to claim 15, Applicant argued that “claim 15 is now directed to an article of manufacture, namely, a computer program product” and therefore is statutory. However, claim 15, as amended, recites the computer program product comprising “a computer readable medium”. On page 8, line 20 of the instant specification, applicant has provided evidence that applicant intends the “medium” to include signals.

As such, the claim is drawn to a form of energy. Energy is not one of the four categories of invention and therefore this claim(s) is/are not statutory. Energy is not a series of steps or acts and thus is not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not a combination of substances and therefor not a composition of matter.

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The claims therefore lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category.

Similarly, claim 32 recites "a system". However, the claim lacks the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

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In the case of amending the Claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

The prior art made of record, listed on form PTO-892, and not relied upon, if any, is considered pertinent to applicant's disclosure.

If a reference indicated as being mailed on PTO-FORM 892 has not been enclosed in this action, please contact Lisa Craney whose telephone number is **(571) 272-3574** for faster service.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh B. Pham whose telephone number is (571) 272-4116. The examiner can normally be reached on Monday through Friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Khanh B. Pham/
Primary Examiner
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December 14, 2009